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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,041	12/21/2001	Mary M. DaRif	6962	8619

7590 05/24/2005

The Sherwin-Williams Company
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EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,041

Applicant(s)

DARIF ET AL.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 25, 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Teter et al. (U.S. Patent No. 6,112,665).

The applicant's admitted prior art in the specification page 2, lines 10-14 discloses the idea of covering a color card with a single color. The applicant's admitted prior art in the specification page 2, lines 10-14 does not disclose the idea of placing perforations in the card to form a detachable paint chip section. Teter et al. shows in figures 4 and 5 the idea of placing perforations (14) within a colored section in order to allow the perforated area to be removed. In view of the teachings of Teter et al. it would have been obvious to one in the art to modify the applicant's admitted prior art in the specification page 2, lines 10-14 by adding perforations to the color card to form a detachable chip section since this would allow an opening to be formed within the color coated card which would allow better color matching to be performed, as taught by Teter et al., column 4, lines 55-65. In regard to claim 2, when the perforated section is removed from the card a window would be created. In regard to claims 3 and 13, applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Teter et al. does not disclose the particular shape of the chip section. It would have been an obvious

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matter of design choice to make the chip section square since the applicant fails to provide any advantage to making the chip section square and the round shape taught by applicant's admitted prior art in view of Teter et al. would work equally well. Further, it is considered within one skilled in the art to make the chip section any shape as desired. In regard to claims 4 and 14, applicant's admitted prior art in the specification page 1, lines 10-27 discloses the idea of making the color card from paper. In regard to claim 11, the perforated section, could be separated along three sides and folded along the fourth side as defined.

Claims 5,6,7, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Teter et al. (U.S. Patent No. 6,112,665) as applied to claims 1 and 10 above and further in view of Day et al. (U.S. Patent No. 4,104,809)

Applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 does not disclose placing a formula for the paint color. Day et al. shows in figure 1 the idea of placing indicia for indicating the color of each chip section and indicia for indicating a code/formula for each chip section. In view of the teachings of Day et al. it would have been obvious to one in the art to place the paint formula/code on each of the paint chip sections since this would allow a person to make the desired colored paint in an easier and faster manner. In regard to claim 7, applicant's admitted prior art in view of Teter et al. and Day fail to disclose placing the indicia on the second surface. It is considered to have been obvious to one having ordinary skill in the art to place the indicia on any location of the color card (defined in the applicant's admitted art) as desired, including the second surface. Further, it would have been

obvious to one having ordinary skill in the art to place the indicia on the second surface since this would make the first surface more aesthetically pleasing and would allow the indicia to be seen in an easier manner.

Claims 8 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Teter et al. (U.S. Patent No. 6,112,665) as applied to claims 1 and 10 above and further in view of Edwards (U.S. Patent No. 4,992,050) or Goldsholl (U.S. Patent No. 3,224,113).

The applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Teter et al. disclose the applicant's basic inventive concept except for placing a color coating on the back of each paint card that is the same as the first color coating composition. Edwards discloses in the abstract the idea of placing a first color of paint on a first side of a chip section and a coating of paint on the opposite side of each chip section that is the same color. Edwards discloses that the paint on the second side has a different finish as compared to the first side. Goldsholl discloses in column 1, lines 59-62, the idea of placing paint on the front and back surfaces of a paint card. In view of the teachings of Edwards or Goldsholl it would have been obvious to one in the art to modify applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 by placing a coat of paint on the second surface of each chip section since this would allow the color of the paint to be seen on either side of the chip section, i.e. easier and quicker to determine the paint color shown by the color card. While Edwards and Goldsholl do not specifically disclose making the coating compositions on the first and second surfaces the same, they do teach the idea of placing coating compositions on

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the first and second surfaces of the color card. It is considered within one skilled in the art to make the coating compositions the same to achieve the advantage of determining the paint color in an easier and quicker manner. Further, it is considered within one skilled in the art to place any coating composition on the second surface as desired. Further, the applicant fails to define any advantage to placing the same composition on the second surface as on the first surface.

Claims 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Teter et al. (U.S. Patent No. 6,112,665) as applied to claims 1 and 10 above and further in view of Goldsholl (U.S. Patent No. 3,224,113).

The applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Teter et al. disclose the applicant's basic inventive concept except for placing a color coating on the back of each paint card that has a different color than the first color coating composition. Goldsholl discloses in column 1, lines 59-62 and column 2, lines 40-50, the idea of placing paint on the front and back surfaces of a paint card. Goldsholl suggests in these lines that the colors on the front are different from the colors on the front of the card. In view of the teachings of Goldsholl it would have been obvious to one in the art to modify applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 by placing a coat of paint on the second surface of each chip section that is different in color than the first composition on the first surface since this would allow more colors to be displayed by the color card, i.e. this would allow more colors to be shown by a single paint card.

Response to Arguments

Applicant's arguments filed March 14, 2005 have been fully considered but they are not persuasive.

The applicant argues that there is absolutely no suggestion or motivation to combine the two teachings (applicant's admitted art in view of Teter et al.) that the examiner has used to make the rejection of claims 1-4 and 10-14. The examiner disagrees since Teter et al. discloses in column 4, lines 55-64, that placing a hole in the color card provides a clear advantage to a color card without a hole, i.e. "the swatch cards can be conveniently laid on top of a printed card or product sample in order to obtain the best match possible. Placing the swatches over a product whose color is to be matched and viewing the product color through the hole is preferable to simply laying a swatch next to the color to be matched, as the visual perception is more accurate when the color being matched appears through a hole".

The applicant argues that Teter et al. specifically teaches the use of a color card with a plurality of color swatches and there is no suggestion to use the device of Teter et al. with a single color card. The examiner disagrees since the applicant already discloses that the use of a single color card is known in the art. Teter et al. discloses that it is advantageous to place a hole in a color card. Placing a hole in the applicant's admitted prior art, as taught by Teter et al., would allow for better matching as taught to be desirable by Teter et al.. In view of the teachings of Teter et al. it is considered within one skilled in the art to place an aperture/hole in any type of color card in order to achieve the advantage taught by Teter et al.

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In regard to the applicant's argument that Teter et al. does not contemplate that the color on the swatches are formulated to have a dried color that is substantially similar to the dried color of a commercially available paint composition. The color on the color card of the applicant's admitted prior art would inherently match the color of a commercially available paint composition, i.e. that's the purpose of the color card. Whether the colors on the Teter et al. reference match a commercially available paint composition is immaterial.

In regard to the applicant's argument, with regard to claims 3 and 13, that the applicant's admitted prior art in view of Teter et al. fail to show chip sections which are square. Teter et al. discloses the idea of making the chip sections circular. The applicant fails to define any advantage to making the chip section square. Therefore, the particular shape of the chip section is considered to be a matter of design choice.

The applicant argues that, with regard to claim 11, Teter et al. fails to show a tear line that has ends separated by a space. The examiner disagrees since Teter et al. shows in figure 1 that the perforations (14) include a space between each of them. Further, perforations inherently have a space between each hole/perforation. As broadly defined, one of the non-perforated areas between adjacent perforations is considered to be the space.

The applicant argues that, with regard to claim 7, the prior art of record fails to show the indicia on the second surface. The examiner considers it within one having ordinary skill in the art to place the indicia on any location on the card as desired. Placing the indicia on the second surface would make the first surface more aesthetically pleasing and would allow the indicia to be seen in an easier manner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bkg
May 18, 2005


BRIAN K. GREEN
PRIMARY EXAMINER